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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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7590	12/11/2006		EXAMINER	
IVAN S KAVRUKOV ESQ COOPER & DUNHAM LLP 1185 AVENUE OF THE AMERICAS NEW YORK, NY 10036			LEE, TOMMY D	
			ART UNIT	PAPER NUMBER
			2625	

DATE MAILED: 12/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/459,202	MORI, YUKIKAZU	
	Examiner Thomas D. Lee	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 25 September 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-34 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                 | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                        | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|   | 6) <input type="checkbox"/> Other: _____.                         |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This Office action is responsive to applicant's amendment filed September 25, 2006. Claims 1-34 are pending.

### ***Claim Rejections - 35 USC § 103***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1, 2, 5, 6, 9-14, 18-20, 21/(9-14, 18-20), 22, 25/14 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,052,445 (Bashoura et al.) in view of U.S. Patent 6,437,871 (Yuki).

Regarding claim 1, Bashoura et al. teach a network facsimile device for communicating in at least one of a plurality communication modes for transmitting designated image information to a designated destination, said device comprising: input means for operator input of information identifying a plurality of destination addresses, including for each destination a plurality of address information respectively corresponding to said plurality of communication modes, and for designating one address among said plurality addresses to which the document image information is to be transmitted (column 3, line 63 - column 4, line 7., column 4, lines 15-20 (programming a table to store information inherently requires an operator to input the information intended to be stored)); and address information registering means for registering a plurality of address information respectively corresponding to said plurality of communication modes, input by the operator through said input means, for each

destination (column 4, lines 8-20), wherein an operator uses said input means to (i) designate one of the plurality of destinations, and (iii) then request that the image information be transmitted to the corresponding address of the designated destination through the selected communication mode (in response to a dialed telephone number by a user, a communication mode is selected based on whether an address corresponding to a particular mode is stored (column 4, line 39 – column 5, line 13), and thus a destination (associated with the dialed telephone number) and communication mode (IP or e-mail address) is selected by designating an address (the telephone number dialed by the user)).

Bashoura et al. do not appear to disclose (ii) select any one of said plurality of communication modes available for communicating through said network facsimile device with the designated destination. However, Bashoura et al. noted that “[s]ome Internet users, of course, will have both an IP address and an E-mail address. In this case, both addresses can be stored in the table 7 or, at the option of the user, one or the other.” (column 4, lines 34-37) It would have been obvious to one of ordinary skill in the art that if both addresses are stored in the table, one of the addresses must be selected in order for communication with the designated destination to take place. Therefore, it would have been obvious for one of ordinary skill in the art to modify the teaching of Bashoura et al., by providing a means for selecting a communication mode corresponding to a designated destination.

Scanner means for scanning a document and outputting document image information is provided in a local fax machine 1 connected to fax director 3 (Fig. 1).

While the scanner means, input means and address information registering means are not located in a single device, such a limitation is disclosed in Yuki. Scanner means 2, input means (panel operation portion 1) and address information registering means (memory portion 5) are located within the facsimile apparatus shown in Fig. 1 of Yuki (column 3, lines 29-53). Since all of the components are provided in a single device, probability is enhanced; and a single device may be contained in a smaller area, thereby saving floor space. Therefore, it would have been obvious for one of ordinary skill in the art to modify the teaching of Bashoura et al. by combining the local fax machine, fax director and local computer in a single housing, such as disclosed in Yuki. Bashoura et al. do not teach display means, wherein, when said input means is repeatedly operated at the time of designating the address, a plurality of address information registered are changed over and viewed on said display means in order, as recited in claim 2, or one-touch dial means for enabling a large number of addresses to be registered and to designate the one address by operating the one-touch dial means, as recited in claims 5 and 6. Yuki teaches a facsimile apparatus having a display means for displaying a plurality of registered address information stored in one-touch dial memory (column 5, lines 51-57; column 6, lines 54-59). When one of the destinations is specified by operation of the panel operation portion, a copy operation begins (column 5, lines 56-60; column 6, lines 59-64). By providing a one-touch dial operation, a user may save time in dialing numbers that are frequently used, since only one key corresponding to the telephone number or IP address need be pressed. Therefore, it would have been obvious for one of ordinary skill in the art to modify the

teaching of Bashoura et al., by providing a one-touch dial memory such as taught by Yuki. Repeated operation of input means is merely a scrolling operation for changing addresses or modes of operation on a display, which is well known in the art.

Regarding claim 9, Bashoura et al. teach a network facsimile device for communicating in at least one of a plurality of communication modes for transmitting designated image information to a designated destination, said device comprising: Internet image information communicating means for performing communication of image information through the Internet (column 2, lines 51-56); and public network image information communication means for performing communication of the image information through a public network, wherein said Internet image information communication means and said public network image information communicating means communicate information to a plurality of designated destinations (column 2, lines 56-61); input means for inputting information identifying a plurality of destination addresses, including for each destination a plurality of address information respectively corresponding to said plurality of communication modes, and for designating one address among said plurality of addresses to which the document image information is to be transmitted (column 3, line 63 – column 4, line 7; column 4, lines 15-20 (programming a table to store information inherently requires an operator to input the information intended to be stored)); and address information registering means for registering a plurality of address information respectively corresponding to said Internet image information communicating means and public network image information communicating means, for each designated destination (column 4, lines 8-20), wherein

an operator uses said input means to (i) designate one of the plurality of destinations, and (iii) then request that the image information be transmitted to the corresponding address of the designated destination through the selected communication mode (in response to a dialed telephone number by a user, a communication mode is selected based on whether an address corresponding to a particular mode is stored (column 4, line 39 – column 5, line 13), and thus a destination (associated with the dialed telephone number) and communication mode (IP or e-mail address) is selected by designating an address (the telephone number dialed by the user)).

As mentioned above with respect to claim 1, Bashoura et al. do not appear to disclose (ii) select any one of said plurality of communication modes available for communicating through said network facsimile device with the designated destination. However, Bashoura et al. noted that “[s]ome Internet users, of course, will have both an IP address and an E-mail address. In this case, both addresses can be stored in the table 7 or, at the option of the user, one or the other.” (column 4, lines 34-37) It would have been obvious to one of ordinary skill in the art that if both addresses are stored in the table, one of the addresses must be selected in order for communication with the designated destination to take place. Therefore, it would have been obvious for one of ordinary skill in the art to modify the teaching of Bashoura et al., by providing a means for selecting a communication mode corresponding to a designated destination.

As mentioned above with respect to claim 1, it would have been obvious for one of ordinary skill in the art to modify the teaching of Bashoura et al. by combining the

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local fax machine, fax director and local computer in a single housing, such as disclosed in Yuki.

Regarding claims 10 and 11, Bashoura et al. teach a network facsimile device for communicating in at least one of a plurality of communication modes for transmitting designated image information to a designated destination, said device comprising: electronic-mail type Internet image information communicating means for performing communication of the image information through the Internet by use of electronic mail (column 4, lines 27-38); real-time type Internet image information communicating means for performing communication of the image information through said Internet in real time (column 4, lines 21-26, 34-38); and public network image information communicating means for performing communication of the image information through a public network (column 2, lines 56-61), wherein any one of said electronic-mail type Internet image information communicating means, said real-time type Internet image information communicating means, and said public network image information communicating means communicates information to a plurality of designated destinations (column 4, line 43 - column 5, line 13); and input means for inputting information identifying a plurality of destination addresses, including for each destination a plurality of address information respectively corresponding to said plurality of communication modes, and for designating one address among said plurality of addresses (column 3, line 63 – column 4, line 7; column 4, lines 15-20 (programming a table to store information inherently requires an operator to input the information intended to be stored)); and address information registering means for registering a plurality of address information

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respectively corresponding to said electronic-mail type Internet image information communicating means, said real-time type Internet image information communicating means, and said public network image information communicating means, for each designated destination (column 4, lines 8-20), wherein an operator uses said input means to (i) designate one of the plurality of destinations, and (iii) then request that the image information be transmitted to the corresponding address of the designated destination through the selected communication mode (in response to a dialed telephone number by a user, a communication mode is selected based on whether an address corresponding to a particular mode is stored (column 4, line 39 - column 5, line 13), and thus a destination (associated with the dialed telephone number) and communication mode (IP or e-mail address) is selected by designating an address (the telephone number dialed by the user)). Said plurality of registered address information include an e-mail address for use by said electronic-mail type Internet image information communicating means, an IP address for use by said real- time type Internet image information communicating means, and a telephone number for use by said public network image information communicating means (Fig. 4).

As mentioned above with respect to claim 1, Bashoura et al. do not appear to disclose (ii) select any one of said plurality of communication modes available for communicating through said network facsimile device with the designated destination. However, Bashoura et al. noted that “[s]ome Internet users, of course, will have both an IP address and an E-mail address. In this case, both addresses can be stored in the table 7 or, at the option of the user, one or the other.” (column 4, lines 34-37) It would

have been obvious to one of ordinary skill in the art that if both addresses are stored in the table, one of the addresses must be selected in order for communication with the designated destination to take place. Therefore, it would have been obvious for one of ordinary skill in the art to modify the teaching of Bashoura et al., by providing a means for selecting a communication mode corresponding to a designated destination.

Scanner means for scanning a document and outputting document image information is provided in a local fax machine 1 connected to fax director 3 (Fig. 1). While the scanner means, input means and address information registering means are not located in a single device, such a limitation is disclosed in Yuki. Scanner means 2, input means (panel operation portion 1) and address information registering means (memory portion 5) are located within the facsimile apparatus shown in Fig. 1 of Yuki (column 3, lines 29-53). Since all of the components are provided in a single device, portability is enhanced; and a single device may be contained in a smaller area, thereby saving floor space. Therefore, it would have been obvious for one of ordinary skill in the art to modify the teaching of Bashoura et al. by combining the local fax machine, fax director and local computer in a single housing, such as disclosed in Yuki.

As mentioned above with respect to claim 1, it would have been obvious for one of ordinary skill in the art to modify the teaching of Bashoura et al. by combining the local fax machine, fax director and local computer in a single housing, such as disclosed in Yuki.

Claims 12-14 each recite the display means of claim 2, and thus are rejected for the reasons set forth above.

As mentioned above with respect to claim 2, Bashoura et al. do not teach repeatedly operating the same key at the time of designating the address, thereby changing over and selecting, in order, a plurality of address information registered in said key. However, repeated operation of input means is merely a scrolling operation for changing addresses or modes of operation on a display, which is well known in the art. Providing a key for changing and selecting address information in order would have been an obvious modification for one of ordinary skill in the art, for it allows a user to save time in changing address information. Accordingly, claims 18-20 are rejected for the reasons set forth above with respect to claim 2.

Claims 21 and 25 each recite the one-touch dial means of claims 5 and 6, and thus are rejected for the reasons set forth above.

Claim 22 recites the features of above-rejected claim 10, and further recites the repeated operation of input means similarly recited in claim 20, and is thus rejected, for the reasons set forth above.

Regarding claim 32, the one-touch dial means disclosed in Yuki, as mentioned above with respect to claims 5 and 6, enables operator use of said input means to designate one of the addresses registered for a destination to which the document image information is to be transmitted, and the document image information is transmitted to the designated address.

4. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bashoura et al.

Claim 26 is a method claim corresponding to above-rejected apparatus claim 22. The method steps of the claim are either disclosed or would have been obvious in view of Bashoura et al. (note above rejections of claims 10 and 20, as well as claim 22). Note that the method claim does not require the scanning operation as well as the other operations to be performed in a single device, and thus the step of scanning a document and providing document image information based on the scanned document is performed by the local fax machine of Bashoura et al. (scanning is a standard feature of fax machines).

5. Claims 31 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bashoura et al. as applied to claim 26 above, and further in view of Yuki.

As mentioned above, claim 31 recites the one-touch dial means of claims 5 and 6, and thus is rejected for the reasons set forth above. The one-touch dial means enables operator designation of one of the mail address, the IP address and the telephone number registered for a destination associated with said key; and transmitting the document image information to the address designated by the operator.

6. Claims 3, 4, 7, 8, 15-17, 21/(15-17), 23, 24, 25/(15, 23, 24), 29, 30 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bashoura et al. in view of Yuki and U.S. Patent 5,381,527 (Inniss et al.).

Regarding claims 3 and 34, Bashoura et al. do not teach setting each of a plurality of address information registered by said address information registration means with a transmission priority indicating an order in which communication modes are to be used for transmitting the designated image information to the designated

destination, as recited in claim 3 (claim 34 similarly recites including for each address information, a corresponding priority value indicative of user preferences, and wherein an order in which the communication modes are to be used for transmitting the designated image information to the designated destination is determined according to the priority values corresponding to the respective communication modes). Inniss et al. teach a system for efficient message distribution, wherein methods of communicating messages are prioritized (column 3, line 33 – column 4, line 5). By prioritizing the communication modes, the transmitting of any type of message may be performed with greater efficiency. A user may know which destinations are capable of operating under certain modes of communication, and may prioritize based on such knowledge so as to avoid possible errors in transmission. Thus, it would have been obvious for one of ordinary skill in the art to modify the teaching of Bashoura et al. by providing means for setting a priority order for communicating messages, such as taught by Inniss et al.

Claim 4 further recites repeatedly operating the same key at the time of selecting the address, thereby changing over and selecting plural address information registered on said key in accordance with said transmission priority order. As mentioned above with respect to claim 2, repeated operation of input means is merely a scrolling operation for changing addresses or modes of operation on a display, which is well known in the art. Providing a key for changing and selecting address information according to a priority order would have been an obvious modification for one of ordinary skill in the art, for it allows a user to save time in changing priorities for each destination.

Claims 7 and 8 each recite the one-touch dial means of claims 5 and 6. As mentioned above, Yuki teaches a facsimile apparatus having a display means for displaying a plurality of registered address information stored in one-touch dial memory (column 5, lines 51-57; column 6, lines 54-59). When one of the destinations is specified by operation of the panel operation portion, a copy operation begins (column 5, lines 56-60., column 6, lines 59-64). By providing a one-touch dial operation, a user may save time in dialing numbers that are frequently used, since only one key corresponding to the telephone number or IP address need be pressed. Therefore, it would have been obvious for one of ordinary skill in the art to modify the combined teaching of Bashoura et al. and Inniss et al., by providing a one-touch dial memory such as taught by Yuki.

Claims 15-17 each recite the setting means of claim 3, and are thus rejected for the reasons set forth above.

As mentioned above, claims 21 and 25 recite the one-touch dial means of claims 5 and 6, and thus are rejected for the reasons set forth above.

Claim 23 recites the features of above-rejected claim 10, and further recites registering respective transmission priority orders for each of said mail address, said IP address, and said telephone number; wherein either one of said electronic-mail type Internet image information communicating means, said real-time type Internet image information communication means, and said public network information communicating means is selected in accordance with the transmission priority order respectively registered with said mail address, said IP address, and said telephone number, for

image information transmission to the address selected by operation of said input means. As mentioned above with respect to claim 3, Inniss et al. teach a system for efficient message distribution, wherein methods of communicating messages are prioritized (column 3, line 33 - column 4, line 5). By prioritizing the communication modes, the transmitting of any type of message may be performed with greater efficiency. A user may know which destinations are capable of operating under certain modes of communication, and may prioritize based on such knowledge so as to avoid possible errors in transmission. Thus, it would have been obvious for one of ordinary skill in the art to modify the teaching of Bashoura et al. and Yuki by providing means for setting a priority order for communicating messages, such as taught by Inniss et al.

Claim 24 recites most of the features of claim 23, and further recites repeated operation of input means, thereby changing over and selecting plural addresses in accordance with a transmission priority order. As mentioned above with respect to claim 4, providing a key for changing and selecting address information according to a priority order would have been a obvious modification for one of ordinary skill in the art, for it allows a user to save time in changing priorities for each destination. Accordingly, device claim 24, as well as corresponding method claim 28, is rejected.

Claims 29 and 30 each also recite the one-touch dial means of claims 5 and 6, and thus are rejected as well, for the reasons set forth above.

7. Claims 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bashoura et al. in view of Inniss et al.

Claims 27 and 28 are method claims corresponding to above-rejected apparatus claims 23 and 24, respectively. The method steps of the claims are either disclosed or would have been obvious in view of Bashoura et al. and Inniss et al. (note above rejections of claim as well as claims 23 and 24). Note that the method claims do not require the scanning operation as well as the other operations to be performed in a single device, and thus the step of scanning a document and providing document image information based on the scanned document is performed by the local fax machine of Bashoura et al. (scanning is a standard feature of fax machines).

***Response to Arguments***

8. Applicant's arguments filed in response to the prior rejections under 35 U.S.C. 103(a) as set forth in the prior Office action mailed July 3, 2006 have been fully considered but they are not persuasive.

Applicant asserts that Bashoura does not allow an operator to select one of plural communication modes for communicating with a destination (current amendment: page 21), and thus the cited prior art fail to disclose or suggest applicant's invention as recited in claim 1 (current amendment: page 23). In particular, applicant states that operation of the fax director and look-up table in the system proposed by Bashoura is transparent to the user at the fax machine who, in Bashoura, merely wants to transmit a facsimile and does not care about the communication mode (current amendment: page 22). Applicant furthermore asserts that independent claims 9, 10, 22-24 and 26-28 are patentably distinct from the cited art for at least similar reasons, and thus all of the pending claims are patentable over the cited art (current amendment: page 23). It

should be noted, however, that when an Internet user has both an IP address and an E-mail address, both addresses, or one or the other, can be stored in the look-up table in the system of Bashoura. It would have been obvious to one of ordinary skill in the art that if both addresses are stored in the table, one of the addresses must be selected by a user in order for communication with the designated destination to take place. If a communication mode were to be selected automatically (as suggested in applicant's argument), there would be no need to store both addresses in the table. Thus, when both addresses are stored in the table, it would have been obvious for one of ordinary skill in the art to provide means for enabling a user to select one of the addresses for communication with the destination. Furthermore, as mentioned above with respect to claim 3, Inniss et al. teach a system for efficient message distribution, wherein methods of communicating messages are prioritized (column 3, line 33 – column 4, line 5). The prioritization of communication modes inherently requires user selection of a communication mode for communicating with a destination.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent 4,920,560 (Kageyama) discloses a facsimile apparatus having an automatic dialing function, wherein a plurality of telephone numbers are set for each abbreviated number in a memory, and the numbers are dialed according to a priority order.

***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas D. Lee whose telephone number is (571) 272-7436. The examiner can normally be reached on Monday-Friday, 7:30-5:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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